Remarks

Claim 31 has been amended to recite a method for applying a "strippable" finish to a substrate. Following entry of this amendment, claims 1-19 and 31-40 will be pending in this application.

The Examiner may wish to refer to the Declaration of Robert D. P. Hei Under 37 C.F.R. §1.132 (the "Hei Declaration") filed June 30, 2004 in copending Application Serial No. 09/560,170. The Hei Declaration addresses most of the issues raised in the present Office Action and is occasionally cited or quoted below. If desired by the Examiner, applicants can submit a new declaration from Dr. Hei limited to the issues raised in the present Office Action. Applicants believe however that the issues are relatively straightforward and can be fully addressed by the present remarks and portions of the already-submitted Hei Declaration.

Rejection of Claims 1-19 under 35 U.S.C. §102(b)

Claims 1-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Published PCT Application No. WO 98/11168 (Hamrock et al.), on grounds *inter alia* that "All limitations of the claimed invention are either disclosed or inherent in the above reference". Applicants respectfully disagree. Hamrock et al. describe a vinyl floor coating system that may employ a primer coating (which solely for purposes of discussion could be referred to as an "intermediate coating") and a 100% solids radiation curable overcoat. The overcoat is based on a specially formulated polyfunctional isocyanurate monomer. Hamrock et al. do not disclose a "coated substrate comprising a strippable intermediate coating atop the substrate, and a strip agent-permeable coating atop the intermediate coating, wherein the strip agent-permeable coating comprised a waterborne composition" as recited in rejected claims 1-19. Hamrock et al.'s 100% solids radiation curable overcoat is not a waterborne composition. Moreover, a person having ordinary skill in the floor finish art who consulted Hamrock et al. would not use a waterborne composition atop Hamrock et al.'s intermediate coating. Hamrock et al. say that commercially available aqueous emulsion based floor finishes "have been less than completely satisfactory for several reasons" including their "relatively low

solids content" and the need to dry each successive application of the finish composition "before additional coatings are applied and/or before pedestrian traffic is allowed across the treated floor" (see page 1, lines 19-27). These are reasons **not** to use a waterborne composition atop Hamrock et al.'s intermediate coating (see also paragraph 6 in the Hei Declaration). Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-19 as being anticipated by Hamrock et al.

Rejection of claims 1-7, 9-12, 15, 16, 18, 19 and 31-38 under 35 U.S.C. §102(b)

Claims 1-7, 9-12, 15, 16, 18, 19 and 31-38 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,421,782 (Bolgiano et al.), on grounds *inter alia* that "Bolgiano et al. disclose flooring materials and a process for making such flooring materials whereby a substrate **(corresponding to the intermediate coating of the claimed invention)** is treated with a solution comprising water, acrylic acid and a surfactant **(corresponding to the topcoat of the claimed invention and meeting the limitations that the topcoat is UV curable and comprises an acrylate)**" (emphasis in original). Applicants respectfully disagree. Bolgiano et al. describe a factory process for coating vinyl flooring tiles. A radiation-curable first layer (which solely for purposes of discussion could be referred to as an "intermediate coating") is applied to the tiles followed by a second layer containing water, acrylic acid and a surfactant. This is in some respects the inverse of applicants' claimed coated substrate and claimed method. Bolgiano et al.'s second layer would be *more* strippable than Bolgiano et al.'s intermediate coating. Bolgiano et al.'s second layer contains no initiator. If coated by itself, it would not polymerize and would easily be stripped. Bolgiano et al.'s first layer is nonaqueous (see, e.g., col. 6, lines 11 and 53), is applied and cured using factory-type coating conditions in which the moving coated tiles are passed under medium pressure mercury lamps (see e.g., col. 5, lines 46-53), is not said to be strippable, and would be expected by a person skilled in the art to be very difficult to strip. Bolgiano et al. do not show and actually teach away from applicants' claimed coated substrate and method.

Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-7, 9-12, 15, 16, 18, 19 and 31-38 as being anticipated by Bolgiano et al.

Rejection of claims 31-40 under 35 U.S.C. §103(a)

Claims 31-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hamrock et al. in view of U.S. Patent No. 6,444,134 B1 (Holman et al.), on grounds *inter alia* that "it would have been obvious to one having ordinary skill in the art to replace the radiation curable coating comprising a polyfunctional isocyanurate and a hydroxyalkyl acrylate, as taught by Hamrock et al., with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents given that Holman et al. specifically teach that such water-borne coatings exhibit high hardness, flexibility, UV resistance, chemical resistance and abrasion resistance." Applicants respectfully disagree. Holman et al. do not describe finishes like those described by Hamrock et al., and do not relate to a method for applying a strippable finish as recited in claims 31-35 and 40, do not relate to a coated substrate as recited in claim 39 and do not relate to a method for removing a finish from a substrate as recited in claims 36-38. Holman et al. describe a hardwood floor refinishing system meant to avoid the sanding step that typically is required when completely removing and renewing a hardwood floor finish (see e.g., col. 1, lines 9-35 and col. 2, lines 18-20). Hardwood floors whose finish has deteriorated are usually sanded to remove the old finish and then recoated (see e.g., Holman et al. at col. 1, lines 15-35). Holman et al. propose to instead etch an existing hardwood floor finish using a caustic solution (see e.g., col. 2, lines 30-38 and col. 3, lines 39-50), to rinse the etched surface and then to apply a water-based renewal finish. Holman et al. do not strip the underlying finish and do not say that their renewal finish is strippable. Holman et al. leave some of the underlying finish in place and apply the renewal finish over it (see e.g., col. 2, lines 34-37). Holman et al. also say that their renewal finish has "chemical resistance" (see e.g., col. 4, lines 31-35 and 59-63). A person having ordinary skill in the floor finish art who consulted Holman et al. would not use Holman et al.'s renewal finish where strippability was desired. Chemical resistance is **contrary** to strippability and a reason **not** to use Holman et

al.'s renewal finish. It is also a reason **not** to use Holman et al.'s renewal finish in place of Hamrock et al.'s radiation curable overcoat (see also paragraphs 6-10 in the Hei Declaration). In Dr. Hei's words (see paragraph 8 in the Hei Declaration):

> "In my opinion a person having ordinary skill in the resilient floor finish art would not substitute a part of Holman et al.'s system (namely, the chemically resistant water-based renewal finish) for a part of Hamrock et al.'s system (namely, the 100 % solids radiation curable topcoat). Doing so would involve substituting a component of a hardwood floor refinishing system that is not said to be strippable for the upper layer of a vinyl floor coating system that should be strippable. Doing so would also be contrary to Hamrock et al.'s statements that finishes with an aqueous emulsion formulation, low solids content or an air drying requirement are "not completely satisfactory". Moreover, doing so would be contrary to the ordinary expectation of persons skilled in the resilient floor finish art that a "chemically resistant" coating should not be used where strippability is required. Thus for at least these reasons I do not believe that a person having ordinary skill in the resilient floor finish art would combine Hamrock et al. and Holman et al. as proposed in the Office Action."

Applicants accordingly request withdrawal of the 35 U.S.C. §103 (a) rejection of claims 31-40 as being unpatentable over Hamrock et al. in view of Holman et al..

Conclusion

Hamrock et al.'s 100% solids radiation curable overcoat is not a waterborne composition and does not anticipate claims 1-19. Bolgiano et al.'s second layer would be *more* strippable than Bolgiano et al.'s intermediate coating and does not anticipate claims 1-7, 9-12, 15, 16, 18, 19 and 31-38. For at least the reasons recited above and in the cited portions of the Hei Declaration, a person having ordinary skill in the resilient floor finish art would not substitute Holman et al.'s chemically resistant water-based renewal finish for Hamrock et al.'s 100 % solids radiation curable topcoat, and thus Hamrock et al. and Holman et al. do not make obvious claims 31-40. Withdrawal of the rejections and passage of the application to

the issue branch are requested. The Examiner is encouraged to telephone the undersigned attorney at 612-331-7412 to discuss any unresolved questions regarding this application.

Respectfully submitted on behalf of
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